

Remarks

The present Amendment and Response is believed to be fully responsive to the Non-final Office Action dated March 17, 2009. After entry of the present Amendment and Response, Claims 76-96 remain pending. By this Amendment, independent Claims 76, 86, and 96 have been amended. Claims 1-75 were previously cancelled without prejudice. It is respectfully submitted that no new matter has been added by the foregoing amendments. Reconsideration of the application is requested in view of the following remarks.

The Attorney for the Assignee would like to thank the Examiner for the telephonic Examiner's Interview that was conducted on June 2, 2009. In the interview, an agreement was reached with respect to the rejections under 35 U.S.C. § 101. Additionally, an agreement was reached with respect to the prior art rejections based on *Lawlor* and *Adams*. More specifically, an agreement was reached that neither *Lawlor* nor *Adams*, either taken alone or in combination, teach or suggest the selection of a form of crediting a payee based on at least one of (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee or (ii) comparing a payment amount associated with the received request to a merchant credit limit associated with the payee. Further, an agreement was reached that neither *Lawlor* nor *Adams* teach or suggest the selection of a form for crediting prior to a debiting of a financial account of the payor. Accordingly, it is respectfully asserted that the pending claims of the present application are allowable over *Lawlor* and *Adams*.

Claim Rejections Under 35 U.S.C. § 101

In the Non-final Office Action, Claims 76-85 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. More particularly, the Office Action contends that method Claims 76-85 are not tied to another statutory class of invention and further fail to transform underlying subject matter to a different state or thing.

By the present Amendment, independent Claim 76 has been amended in order to clarify the claimed invention of independent Claim 76. More specifically, independent Claim 76 has been amended to recite “a computer-implemented method” that includes “selecting, by at least

one payment service provider computer ..., a form for crediting the payee ..." (Underlining supplied). It is respectfully asserted that amended independent Claim 76 recites a method claim that is tied to another statutory class of invention. Accordingly, it is respectfully contended that amended independent Claim 76 satisfies the requirements of 35 U.S.C. § 101. Additionally, it is respectfully submitted that dependent Claims 77-85, which ultimately depend from independent Claim 76, satisfy the requirements of 35 U.S.C. § 101. Thus, it is believed that Claims 76-85 are in condition for allowance and prompt allowance of the same is respectfully requested.

Claim Rejections Under 35 U.S.C. §§ 102 & 103

In the Non-Final Office Action, Claims 76-96 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 5,220,501 to Lawlor et al. (hereinafter "*Lawlor*"). Alternatively, Claims 76-96 were rejected under 35 U.S.C. § 103(a) as being obvious over *Lawlor* in view of U.S. Pat. No. 5,177,342 to Adams (hereinafter "*Adams*"). Specifically, the Office Action contends that *Lawlor* discloses a method and system that: receives a request to pay a payee on behalf of a payer; selects a form for crediting the payee based at least in part on at least one of (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme, and (ii) comparing a payment amount associated with the received request to a merchant credit limit; and directed a payment to the payee in accordance with the selected form of crediting. The Office Action recognizes that *Lawlor* does not disclose comparing a payer account number to a merchant account scheme; however, the Office Action contends that *Adams* discloses a system in which a transaction approval terminal determines if an account number is in an allowable format.

Although it is believed that the examined claims are allowable over the cited art reference, in order to expedite the allowance of the present patent application, independent Claims 76, 86, and 96 have been amended to clarify the claimed inventions of the independent claims. More specifically, independent Claim 76 has been amended to recite "selecting, ... prior to a debiting of a financial account of a payor, a form for crediting the payee, wherein the selection is based on at least one of: (i) comparing a payer account number associated with the

payer and the payee to a merchant account scheme associated with the payee; or (ii) comparing a payment amount associated with the received request to a merchant credit limit associated with the payee” (Underlining supplied). Independent Claims 86 and 96 have been amended in a similar manner. Ancillary support for these amendments may be found at least in FIGS. 4A-4C and the associated text of the Specification.

As discussed and agreed in the Examiner’s Interview conducted on June 2, 2009, neither *Lawlor* nor *Adams*, either taken alone or in combination, teach or suggest “selecting a form for crediting the payee ... based on at least one of: (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee or (ii) comparing a payment amount associated with the received request to a merchant credit limit associated with the payee.” Furthermore, neither *Lawlor* nor *Adams* teach or suggest selecting a form for crediting the payee “prior to a debiting of a financial account of the payer,” as recited by the amended independent claims.

With respect to *Lawlor*, there is not teaching or suggestion of selecting a form of crediting the payee prior to a debiting of a financial account of the payor. In marked contrast, *Lawlor* relates to a good funds transaction system in which consumer funds are debited (if available) prior to making any payments on behalf of the consumer (See, e.g., *Lawlor* at col. 11, lines 22-52, col. 33, lines 23-25, and col. 34, lines 35-36). *Lawlor* does not process a payment and credit a payee until after funds are received from the payor. Accordingly, *Lawlor* does not select a form of crediting the payee prior to a financial account of payor being debited.

Further, *Lawlor* does not teach or suggest selecting a form of crediting a payee based on either (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee or (ii) comparing a payment amount associated with the received request to a merchant credit limit associated with the payee. First, as recognized by the Office Action, *Lawlor* does not teach or suggest “a merchant credit limit” and, therefore, does not teach or suggest “comparing a payment amount associated with the received request to a merchant credit limit associated with the payee.” As discussed on at least page 12, lines 9-12, and page 14, lines 14-18 of the Specification, a transaction may be compared to a

merchant limit, also referred to as a merchant credit limit, to determine if the transaction amount exceeds the payment limit for the particular merchant or payee. Because the claimed inventions comprise risk-based systems and methods (i.e., the funds are not required to be present in the account at the time the payment request is processed), such edits are performed to minimize risk. In market contrast to the amended independent claims, *Lawlor* fails to disclose any risk analysis or equivalent payment analysis to determine if a transaction amount exceeds a limit associated with the merchant. In fact, because *Lawlor* discloses a good funds transaction system where a debit is made only if funds are available (see, e.g., col. 11, lines 22-52, col. 33, lines 23-25, and col. 34, lines 35-36), *Lawlor* teaches away from the use of a payment limit associated with a merchant or payee.

Lawlor also fails to teach or suggest “selecting a form of crediting a payee based on comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee,” as recited by amended independent Claims 76, 86, and 96. First, *Lawlor* fails to teach or suggest merchant account scheming. The cited portions of *Lawlor* merely disclose the payment of bills to a remittance center, who in turn pays payees (See *Lawlor* at col. 19, lines 9-11), and the processing of payment requests once a user exits a bill payment routine (See *Lawlor* at col. 49, lines 7-28). This language does not refer to a “payor account number associated with the payer and the payee,” which is the consumer’s account number with the payee or merchant, nor does it teach or suggest the validation of the customer account number to determine if it conforms to an account scheme associated with the payee or merchant. *Lawlor* does refer to a “user account,” but that is the user’s bank account with a financial institution and not a customer account of a consumer with a merchant (See *Lawlor* at col. 34, lines 10-15). Additionally, *Lawlor* fails to teach a selection of a form of credit based on merchant account scheming. Thus, *Lawlor* does not teach or suggest the selection of a form of crediting based on “comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee,” as recited by amended independent Claims 76, 86, and 96.

Adams, either taken alone or in combination with *Lawlor*, also fails to teach or suggest selecting a form for crediting a payee based on at least one of: (i) comparing a payer account number associated with the payer and the payee to a merchant account scheme associated with the payee or (ii) comparing a payment amount associated with the received request to a merchant credit limit associated with the payee.” Although *Adams* relates to a system in which a determination may be made as to whether credit card account number is in a proper format (See *Adams* at col. 5, lines 5-9), there is no teaching or suggestion of selecting a form for crediting a payee based on this determination. Moreover, *Adams* fails teach or suggest selecting a form for crediting the payee “prior to a debiting of a financial account of the payer,” as recited by the amended independent claims.

Accordingly, for at least the reasons stated above, it is respectfully submitted that neither *Lawlor* nor *Adams*, either taken alone or in combination, teach or suggest the limitations of amended independent Claims 76, 86, and 96. Therefore, it is respectfully asserted that Claims 76, 86, and 96 are in condition for allowance. Likewise, dependent Claims 77-85 and 87-95 are allowable as a matter of law in that they depend from an allowable independent claim, notwithstanding their own recitations of patentable subject matter.

Conclusion

It is believed that each matter raised by the Non-final Office Action has been responded to. Allowance of the claims is respectfully solicited. It is not believed that any extensions of time or fees for addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

If there are any issues which can be resolved by telephone conference or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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